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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,430	01/03/2001	Aditya Krishnan	SNY-P4151	1176

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MILLER PATENT SERVICES
2500 DOCKERY LANE
RALEIGH, NC 27606

EXAMINER


SHELEHEDA, JAMES R

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/753,430	Applicant(s) KRISHNAN ET AL. 	
	Examiner James Sheleheda	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 5-8, 14-16, 19, 23-26, 29, 30 and 35-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Moore et al. (Moore) (US2001/0047298).

As to claim 1, Moore discloses a method of presenting entertainment program material (paragraph 32), comprising:

presenting a first presentation of a segment of programming (presenting a program to a user; paragraph 22) having a first window overlaying the segment of programming (overlay window containing an advertisement; Fig. 7; paragraph 47), the first window containing a first segment of ancillary information relevant to the segment of programming (paragraph 22 and 40); and

presenting a second presentation of the segment of programming (replaying the recorded program; paragraph 43, lines 18-23) having a second window overlaying the segment of programming (overlay window containing a "fresh" ad; paragraph 43, lines 18-23 and Fig. 7), the second window containing a second segment of ancillary

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information relevant to the segment of programming (paragraph 40 and paragraph 43, lines 18-23).

As to claim 2, Moore discloses wherein at least the first presenting comprises transmitting the segment of programming to a television set-top box (programs and media transmitted to user equipment 160; paragraph 32 and paragraph 35) along with the first and second segment of ancillary information (ad information received and stored locally at the user computer; paragraph 40, paragraph 42 and paragraph 44).

As to claim 3, Moore discloses at a set-top box, selecting the first segment of ancillary information for overlaying in the first presentation (selecting an ad that pertains to a particular media or scene; paragraph 40) and selecting the second segment of ancillary information for overlaying the second presentation (paragraphs 40 and 44).

As to claim 5, Moore discloses wherein the selecting is carried out by selecting one of the segments of ancillary information in accordance with a number of times the segment of programming has been played at the set-top box (wherein a “fresh” ad is selected **each** time the program is replayed; paragraphs 43 and 44).

As to claim 6, Moore discloses

transmitting the segment of programming (programs and media transmitted to user equipment 160; paragraph 32 and paragraph 35) along with a plurality of segments

of ancillary information to a set-top box (ad information received and stored locally at the user computer; paragraph 40, paragraph 42 and paragraph 44); and

at the set top box, selecting the first and second segments of ancillary information for overlaying in the first and second window from the plurality of segments of ancillary information (Fig. 7; selecting an ad that pertains to a particular media or scene; paragraphs 22, 40 and 44).

As to claim 7, Moore discloses counting a number of times the segment of programming is presented to a viewer through the set-top box (wherein a “fresh” ad is presented **each** time the recorded program is replayed, counting if the program has been replayed once; paragraphs 43 and 44).

As to claim 8, Moore discloses selecting the first and second segments of ancillary information in accordance with the number of times the segment has been previously presented (wherein a “fresh” ad is presented **each** time the recorded program is replayed; paragraphs 43 and 44).

As to claim 14, Moore discloses wherein the segment of programming includes a marker indicative of a location for overlaying the window (wherein program data indicative of a particular scene is used to mark when a related ad should be displayed; paragraph 40 and paragraph 22).

As to claim 15, Moore discloses wherein the first window comprises a default window (the initial ad window associated with the media; paragraph 22 and paragraph 43) and wherein the second window overlays the first window (wherein the new ad will replace the previous ad in the program; paragraphs 43 and 44).

As to claim 16, Moore discloses at a service provider (wherein the service provider has embedded meta data into a program indicating the correct advertisement; paragraphs 40, 43 and 44), selecting the first segment of ancillary information for overlaying in the first presentation and selecting the second segment of ancillary information for overlaying the second presentation (Fig. 7; selecting an ad that pertains to a particular media or scene; paragraphs 22, 40 and 44).

As to claim 19, Moore discloses
receiving the segment of programming along with a plurality of segments of ancillary information at a service provider (wherein the media must inherently be received at the broadcast equipment prior to transmission to the user equipment; paragraph 30); and

at the service provider (wherein the service provider has embedded meta data into a program indicating the correct advertisement; paragraphs 40, 43 and 44), selecting the first and second segments of ancillary information for overlaying in the first and second window from the plurality of segments of ancillary information (Fig. 7; selecting an ad that pertains to a particular media or scene; paragraphs 22, 40 and 44).

As to claim 23, Moore discloses wherein the first window comprises a default window (the first ad window associated with the media; paragraph 22 and paragraph 43) and wherein the second window overlays the first window (wherein the new ad will replace the previous ad in the program; paragraphs 43 and 44).

As to claim 24, Moore discloses a method of presenting entertainment program material (paragraph 32), comprising the unordered process of:

presenting a first presentation of a segment of programming (presenting a program to a user; paragraph 22) having a first window overlaying the segment of programming (overlay window containing an advertisement; Fig. 7; paragraph 47), the first window containing a first segment of ancillary information relevant to the segment of programming (paragraph 22 and 40); and

presenting a second presentation of the segment of programming (replaying the recorded program; paragraph 43, lines 18-23) having no second window overlaying the segment of programming (wherein if the advertiser did not provide a “fresh” ad, the same first window and ad would be presented again; paragraph 43).

As to claim 25, Moore discloses a method of presenting entertainment program material (paragraph 32), comprising:

presenting a first presentation of a segment of programming (presenting a program to a user; paragraph 22) having a static window overlaying the segment of

programming (the initial ad window associated with the media; paragraph 22 and paragraph 43 and 47), the first window containing a static segment of ancillary information relevant to the segment of programming (the initial ad associated with the media segment; paragraph 22 and 40); and

presenting a second presentation of the segment of programming (replaying the recorded program; paragraph 43, lines 18-23) having a second window overlaying the segment of programming (overlay window containing a “fresh” ad; paragraph 43, lines 18-23 and Fig. 7), the second window containing a variable segment of ancillary information relevant to the segment of programming (wherein the second window contains a newly added ad to replace the previous advertisement; paragraph 40 and paragraph 43, lines 18-23).

As to claim 26, Moore discloses a television set-top box (Fig. 1; user equipment, 160) method of presenting entertainment program material (paragraph 32), comprising:

a receiver (Fig. 2, receiver, 220) for receiving signals representing segments of programming and signals representing a plurality of segments of ancillary information (paragraph 35, lines 1-12), and delivering the signals representing segments of programming to a display interface (audio/video circuitry 215 converting the signals for display, 270; paragraph 35);

a central processor (processor, 280);

program means operating on the programmed processor (wherein a program is inherently running on the processor to control the system) for:

delivering a first presentation of a segment of programming (presenting a program to a user; paragraph 22) having a first window overlaying the segment of programming (overlay window containing an advertisement; Fig. 7; paragraph 47), the first window containing a first segment of ancillary information relevant to the segment of programming (paragraph 22 and 40); and

delivering a second presentation of the segment of programming (replaying the recorded program; paragraph 43, lines 18-23) having a second window overlaying the segment of programming (overlay window containing a “fresh” ad; paragraph 43, lines 18-23 and Fig. 7), the second window containing a second segment of ancillary information relevant to the segment of programming (paragraph 40 and paragraph 43, lines 18-23).

As to claim 29, Moore discloses counting a number of times the segment of programming is presented to a viewer through the set-top box (wherein a “fresh” ad is presented **each** time the recorded program is replayed, counting if the program has been replayed once; paragraphs 43 and 44).

As to claim 30, Moore discloses selecting the first and second segments of ancillary information in accordance with the number of times the segment has been previously presented (wherein a “fresh” ad is presented **each** time the recorded program is replayed; paragraphs 43 and 44).

As to claim 35, Moore discloses wherein the segment of programming includes a marker indicative of a location for overlaying the window (wherein program data indicative of a particular scene is used to mark when a related ad should be displayed; paragraph 40 and paragraph 22).

As to claim 36, Moore discloses wherein the first window comprises a default window (the initial ad window associated with the media; paragraph 22 and paragraph 43) and wherein the second window overlays the first window (wherein the new ad will replace the previous ad in the program; paragraphs 43 and 44).

As to claim 37, Moore discloses a television set-top box (Fig. 1; user equipment, 160) method of presenting entertainment program material (paragraph 32), comprising:

a receiver (Fig. 2, receiver, 220) for receiving signals representing segments of programming and signals representing a plurality of segments of ancillary information (paragraph 35, lines 1-12), and delivering the signals representing segments of programming to a display interface (audio/video circuitry 215 converting the signals for display, 270; paragraph 35);

a central processor (processor, 280);

program means operating on the programmed processor (wherein a program is inherently running on the processor to control the system) for:

delivering a first presentation of a segment of programming (presenting a program to a user; paragraph 22) having a first window overlaying the segment

of programming (overlay window containing an advertisement; Fig. 7; paragraph 47), the first window containing a first segment of ancillary information relevant to the segment of programming (paragraph 22 and 40); and

delivering a second presentation of the segment of programming (replaying the recorded program; paragraph 43, lines 18-23) having no second window overlaying the segment of programming (wherein if the advertiser did not provide a “fresh” ad, the same first window and ad would be presented again; paragraph 43).

As to claim 38, Moore discloses a television set-top box (Fig. 1; user equipment, 160) method of presenting entertainment program material (paragraph 32), comprising:

a receiver (Fig. 2, receiver, 220) for receiving signals representing segments of programming and signals representing a plurality of segments of ancillary information (paragraph 35, lines 1-12), and delivering the signals representing segments of programming to a display interface (audio/video circuitry 215 converting the signals for display, 270; paragraph 35);

a central processor (processor, 280);

program means operating on the programmed processor (wherein a program is inherently running on the processor to control the system) for:

delivering a first presentation of a segment of programming (presenting a program to a user; paragraph 22) having a static window overlaying the segment of programming (the initial ad window associated with the media; paragraph 22

and paragraph 43 and 47), the first window containing a static segment of ancillary information relevant to the segment of programming (the initial ad associated with the media segment; paragraph 22 and 40); and

delivering a second presentation of the segment of programming (replaying the recorded program; paragraph 43, lines 18-23) having a second window overlaying the segment of programming (overlay window containing a "fresh" ad; paragraph 43, lines 18-23 and Fig. 7), the second window containing a variable segment of ancillary information relevant to the segment of programming (wherein the second window contains a newly added ad to replace the previous advertisement; paragraph 40 and paragraph 43, lines 18-23).

As to claim 39, Moore discloses a storage medium storing instructions (storage units, 230-260, paragraph 35) which, when executed on a programmed processor (processor, 280), carry out a method of presenting entertainment program material (paragraph 32), comprising:

presenting a first presentation of a segment of programming (presenting a program to a user; paragraph 22) having a first window overlaying the segment of programming (overlay window containing an advertisement; Fig. 7; paragraph 47), the first window containing a first segment of ancillary information relevant to the segment of programming (paragraph 22 and 40); and

presenting a second presentation of the segment of programming (replaying the recorded program; paragraph 43, lines 18-23) having a second window overlaying the

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segment of programming (overlay window containing a “fresh” ad; paragraph 43, lines 18-23 and Fig. 7), the second window containing a second segment of ancillary information relevant to the segment of programming (paragraph 40 and paragraph 43, lines 18-23).

As to claim 40, Moore discloses a storage medium storing instructions (storage units, 230-260, paragraph 35) which, when executed on a programmed processor (processor, 280), carry out a method of presenting entertainment program material (paragraph 32), comprising:

presenting a first presentation of a segment of programming (presenting a program to a user; paragraph 22) having a first window overlaying the segment of programming (overlay window containing an advertisement; Fig. 7; paragraph 47), the first window containing a first segment of ancillary information relevant to the segment of programming (paragraph 22 and 40); and

presenting a second presentation of the segment of programming (replaying the recorded program; paragraph 43, lines 18-23) having no second window overlaying the segment of programming (wherein if the advertiser did not provide a “fresh” ad, the same first window and ad would be presented again; paragraph 43).

As to claim 41, Moore discloses a storage medium storing instructions (storage units, 230-260, paragraph 35) which, when executed on a programmed processor

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(processor, 280), carry out a method of presenting entertainment program material (paragraph 32), comprising:

presenting a first presentation of a segment of programming (presenting a program to a user; paragraph 22) having a static window overlaying the segment of programming (the initial ad window associated with the media; paragraph 22 and paragraph 43 and 47), the first window containing a static segment of ancillary information relevant to the segment of programming (the initial ad associated with the media segment; paragraph 22 and 40); and

presenting a second presentation of the segment of programming (replaying the recorded program; paragraph 43, lines 18-23) having a second window overlaying the segment of programming (overlay window containing a "fresh" ad; paragraph 43, lines 18-23 and Fig. 7), the second window containing a variable segment of ancillary information relevant to the segment of programming (wherein the second window contains a newly added ad to replace the previous advertisement; paragraph 40 and paragraph 43, lines 18-23).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 4, 9-13, 17, 22, 27, 28 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore.

As to claims 4, 9, 17, 22, 27, while Moore discloses selecting the first and second segments of ancillary information, he fails to specifically disclose wherein the selection is random.

The examiner takes official notice that it is notoriously well known in the art to make selections between a series of items randomly, such as when a multitude of equally valid items are available, for the typical benefit of easily selecting one of plural ads which are valid for a viewer.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Moore's system to include wherein the selection is performed randomly for the typical benefit of easily selecting one of plural ads which are valid for a viewer.

As to claim 28, Moore discloses wherein the selecting is carried out by selecting one of the segments of ancillary information in accordance with a number of times the segment of programming has been played at the set-top box (wherein a "fresh" ad is selected **each** time the program is replayed; paragraphs 43 and 44).

As to claims 10, 11, 12, 13, 31, 32, 33 and 34, while Moore discloses first and second windows, he fails to specifically disclose wherein the windows are the same size

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and shape, of differing sizes and shapes, overlay the same segment of programming or overlay differing segments of programming.

The examiner takes official notice that it is notoriously well known in the art that overlay window can utilize any display characteristic desired, including any particular size, shape, or position on screen, for the typical benefit of allowing the service provider maximum flexibility in how information is presented to a viewer.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Moore's system to include any of wherein the windows are the same size and shape, of differing sizes and shapes, overlay the same segment of programming or overlay differing segments of programming for the typical benefit of allowing the service provider maximum flexibility in how information is presented to a viewer.

5. Claims 18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore as applied to claim 16 above, and further in view of Huizer et al. (Huizer) (5,873,022).

As to claim 18, while Moore discloses wherein the selecting is carried out by selecting one of the segments of ancillary information in accordance with a number of times the segment of programming has been played (wherein a "fresh" ad is selected **each** time the program is replayed; paragraphs 43 and 44), he fails to specifically disclose wherein the segment is transmitted by the service provider each time the segment is replayed.

In an analogous art, Huizer discloses a video distribution system (Fig. 1) wherein the service provider (VOD server, 1) acts as a remote video recorder for a user (column 3, lines 47-58) and provides programming to be played back for a user (column 3, lines 31-58). This provides the typical benefit of reducing the cost of complexity of a home user's equipment by providing video storage at a headend facility.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Moore's system to include wherein the segment is transmitted by the service provider each time the segment is replayed, as taught by Huizer, for the typical benefit of reducing the cost of complexity of a home user's equipment by providing video storage at a headend facility.

As to claim 20, while Moore discloses counting a number of times the segment of programming is presented to a viewer (wherein a "fresh" ad is presented **each** time the recorded program is replayed, counting if the program has been replayed once; paragraphs 43 and 44), he fails to specifically disclose wherein the segment is transmitted by the service provider each time the segment is presented.

In an analogous art, Huizer discloses a video distribution system (Fig. 1) wherein the service provider (VOD server, 1) acts as a remote video recorder for a user (column 3, lines 47-58) and provides programming to be played back for a user (column 3, lines 31-58). This provides the typical benefit of reducing the cost of complexity of a home user's equipment by providing video storage at a headend facility.

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It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Moore's system to include wherein the segment is transmitted by the service provider each time the segment is presented, as taught by Huizer, for the typical benefit of reducing the cost of complexity of a home user's equipment by providing video storage at a headend facility.

As to claim 21, Moore discloses selecting the first and second segments of ancillary information in accordance with the number of times the segment has been previously transmitted (wherein a "fresh" ad is presented **each** time the recorded program is replayed; see Moore at paragraphs 43 and 44).

Conclusion

6. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on _____
(Date)

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Typed or printed name of person signing this certificate:

Signature: _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703)_____ - _____ on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (703) 305-8722. The examiner can normally be reached on 9:00-5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703) 305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Sheleheda
Patent Examiner
Art Unit 2614

JS



JOHN MILLER
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